UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,279	03/29/2001	Kazutoyo Maehiro	6514-4	3873

			EXAMINER
7055	7590	08/05/2004	NAWAZ, ASAD M

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ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/821,279	MAEHIRO, KAZUTOYO
	Examiner	**Art Unit**	
	Asad M Nawaz	2155	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 March 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

1.   Claims 1-15 are pending.

Claim Rejections - 35 USC § 112

2.   Claims 1, 4, 7, 10, and 13 are rejected under 35 U.S.C. 112, second

paragraph, as being incomplete for omitting essential elements, such omission

amounting to a gap between the elements. See MPEP § 2172.01. The omitted

elements are: the user interacting with said first client system and said second

client system.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Gudjonsson (US Provisional Application 60/133,401) and in further view of

Manber et al. (US Patent No. 6,651,086).

As to claim 1, Gudjonsson teaches a client system in a message

exchanging system comprising a plurality of client systems and at least one

server system connected together via a communications network, the server

system authenticating each user of said plurality of client systems and

accumulating and distributing messages, said plurality of client systems

exchanging messages via said server system, the client system comprising: (pg 2, lines 1-10, 19-25; pg 3, lines 1-3; pg 4, lines 1-4; pg 5, lines 4-5, 15-22; pg 6, lines 1-7; pg 15, lines 2-6; pg 17, lines 23-24)

a first message exchanging system that enables one-to-one message exchanges with a first client system of said plurality of client systems; (pg 6, lines 12-18; pg 7, lines 1-4, 15-20; pg 12, lines 22-26; pg 13, lines 1-2; pg33, lines 16-25; pg 34, lines 1-15; pg 39, lines 16-22; pg 40, lines 1-8)

a second message exchanging system that enables simultaneous message exchanges with at least one additional second client systems of said plurality of client systems; (pg 35, lines 17-23; pg 36, lines 1-2; pg 44, lines 15-20; pg 73, lines 1-24; pg 79, lines 15-22)

and message exchange switching system that switches between said first message exchanging system and said second message exchanging system, to enable message exchanges with said first and at least one additional client systems. (pg 44, lines 15-20; pg 54, lines 9-18)

With respect to the limitation, "when said client system receives a message from said second client system while said first message exchanging system is exchanging messages with said first client system" in claim 1, Gudjonsson does not explicitly indicate a second client system contacting the client system. Manber et al., however, teaches a system and a method for connecting two or more individuals to an Internet conversation based on their mutual interests where the user is presented with an option to start or join a conversation. If the user desires to join a conversation, the user must send a

comment to the "owner" of the conversation. The owner then, based on the

user's comment, would either allow the user to enter the chat or disallow them.

This system can be employed from two to many users. (Abstract; Fig 2; col 2,

lines 1-13; col 4, lines 10-20; col 5, lines 25-35)

With respect to claim 1, it would have been obvious to a person of

ordinary skill in the art at the time the invention was made to incorporate the

teachings of Manber et al. into those of Gudjonsson to make the system simpler

and easier for the novice user of instant messaging/chat applications. The

combination of the two references would allow a user to follow a more definitive

path to join a chat session.

As to claim 2, Gudjonsson teaches a client system according to claim 1,

wherein said message exchange switching system sets in said server system an

environment for allowing said second message exchanging system to exchange

messages when said message exchange switching system switches from said

first message exchanging system to said second message exchange switching

system. (pg 44, lines 15-20; pg 54, lines 9-18; pg 73, lines 1-24; pg 81, lines 13-

18; pg 82, lines 1-19)

As to claim 3, Gudjonsson teaches a client system according to claim 2,

wherein said first message exchanging system displays exchanged transmitted

and received messages in one display screen in the order of transmissions and

receptions. (pg 14, lines 21-22; pg 40, lines 5-6; pg 43, lines 1-10; pg 56, lines

12-23)

Claims 10-12 are rejected for essentially being a computer-readable recording medium for the system of claims 1-3.

Claims 13-15 are rejected for essentially being a program product for the system of claims 1-3.

As to claim 4, Gudjonsson teaches a message exchanging method for a client system in a message exchanging system comprising a plurality of client systems and at least one server system connected together via a communications network, the server system authenticating each user of said plurality of client systems and accumulating and distributing messages, said plurality of client systems exchanging messages via said server system, the method comprising: (pg 2, lines 1-10, 19-25; pg 3, lines 1-3; pg 4, lines 1-4; pg 5, lines 4-5, 15-22; pg 6, lines 1-7; pg 15, lines 2-6; pg 17, lines 23-24)

enabling one-to-one message exchanges with a first client system of said plurality of client systems; (pg 6, lines 12-18; pg 7, lines 1-4, 15-20; pg 12, lines 22-26; pg 13, lines 1-2; pg33, lines 16-25; pg 34, lines 1-15; pg 39, lines 16-22; pg 40, lines 1-8)

enabling simultaneous message exchanges with at least one other second client system of said plurality of client systems; (pg 35, lines 17-23; pg 36, lines 1-2; pg 44, lines 15-20; pg 73, lines 1-24; pg 79, lines 15-22)

and switching between the one-to-one message exchanging and the simultaneous message exchanging to enable message exchanges with said first and second client systems. (pg 44, lines 15-20; pg 54, lines 9-18)

With respect to the limitation, "when said client system receives a message from said second client system while said first message exchanging system is exchanging messages with said first client system" in claim 1, Gudjonsson does not explicitly indicate a second client system contacting the client system. Manber et al., however, teaches a system and a method for connecting two or more individuals to an Internet conversation based on their mutual interests where the user is presented with an option to start or join a conversation. If the user desires to join a conversation, the user must send a comment to the "owner" of the conversation. The owner then, based on the user's comment, would either allow the user to enter the chat or disallow them. This system can be employed from two to many users. (Abstract; Fig 2; col 2, lines 1-13; col 4, lines 10-20; col 5, lines 25-35)

With respect to claim 4, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Manber et al. into those of Gudjonsson to make the system simpler and easier for the novice user of instant messaging/chat applications. The combination of the two references would allow a user to follow a more definitive path to join a chat session.

As to claim 5, Gudjonsson teaches a message exchanging method for a client system according to claim 4, wherein said switching sets in said server system an environment for allowing exchanging of messages when said switching switches. (pg 44, lines 15-20; pg 54, lines 9-18; pg 73, lines 1-24; pg 81, lines 13-18; pg 82, lines 1-19)

As to claim 6, Gudjonsson teaches a message exchanging method for a client system according to claim 5, further comprising displaying exchanged transmitted and received messages in one display screen in the order of transmissions and receptions. (pg 14, lines 21-22; pg 40, lines 5-6; pg 43, lines 1-10; pg 56, lines 12-23)

Claims 7-9 are rejected for essentially being the message exchanging system in which the system of claims 4-6 resides.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M Nawaz whose telephone number is (703) 305-0094. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

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Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

AMN

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER